

The claims remaining in the application are 1, 3-5, 10-13, 15-17, and 22-24.

#### REMARKS

The Applicant would like to thank the Examiner for the quick and courteous final Office Action, and particularly for the indication that Applicant's previous amendment overcame the rejections over Thomas, Mishra and Beazley. The Applicant also appreciates the indication that there method claims are allowable over the remaining reference of Atkinson.

#### Objection to Specification under 35 U.S.C. §132

The Examiner objected to the Amendment filed 11/12/03 under 35 U.S.C. §132 because it introduces new matter into the disclosure. 35 U.S.C. §132 states that no amendment shall introduce new matter into the disclosure. The Examiner asserts that added material which is not supported by the original disclosure is as follows: the addition of the compound hexamethylenetetramine. The Examiner required the Applicant to cancel the new matter in reply to this Office Action.

The Examiner's attention is respectfully directed to the amendment to the paragraph on page 4, lines 10-17 where the word "hexamethylenetetramine" has been deleted from this paragraph. It is respectfully submitted that this objection has been overcome by this change and reconsideration is respectfully requested.

#### Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 1, 3-5, 10-13, 15-17 and 22-24 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the invention was filed, had possession of the claimed invention. The addition of hexamethylenetetramine to the claims allegedly adds new matter, since the compound was not described in the specification at the time of filing.

The Applicant would respectfully direct the Examiner's attention to the amendments to claims 1, 12 and 13 herein where the word "hexamethylenetetramine" has been deleted. It is respectfully submitted that this objection has been overcome by these changes, and reconsideration is respectfully requested.

Rejection under 35 U.S.C. §103(a) over Atkinson

The Examiner has rejected claims 1, 3, 10, and 12 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Pat. No. 5,846,450 to Atkinson for reasons of obviousness.

The Examiner finds that Atkinson teaches a brine which comprises formates, such as potassium formate, and which can further comprise water, ammonia and corrosion inhibitors such as triazoles. The levels of as high as 70% potassium formate would result in brines within the density level of greater than 11 lbs/gal. Atkinson is seen by the Examiner to teach that a combination of water and ammonia may be used as a solvent. The Examiner admits that Atkinson differs in that a combination of water and ammonia as the solvent is not disclosed in an example, and a specific example of using a triazole is not disclosed. However, the Examiner contends that it would be obvious to vary the amount of ammonia and water as a combination solvent, including within the concentration ranges of the present invention, in the invention of Atkinson, given the teaching of Atkinson that such combinations may be used as solvents, and may be used to provide specific refrigerant vapor. The Examiner further alleges that the use of triazoles as corrosion inhibitors in the brine of Atkinson would be obvious to one of ordinary skill in the art, given the teaching of Atkinson that such triazoles are useful for corrosion inhibition in the brine. Such triazoles would be encompassed by the teaching of azoles by the claims.

In response to the Applicant's previous arguments and amendments, the Examiner contends that the Applicant's arguments with respect to Atkinson are not deemed fully persuasive. The Examiner notes that the Applicant argued that the term "by absorbing acid" distinguishes over Atkinson, since Atkinson does not teach that the ammonia or triazole performs such absorption. While such may distinguish over the method claims, with respect to the method [composition?] claims, the Examiner asserts that the courts have held that the discovery of a new property of a compound or composition ren-

dered obvious by the prior art, is not by itself a patentable invention (citing *In re Dillon*). The Examiner alleges that the absorbing of the acid is a function of the composition, thus this property does not distinguish over the composition claims.

The Applicant must respectfully traverse.

To support an obviousness rejection, the Examiner has the initial burden of establishing a *prima facie* case of obviousness of the pending claims over the cited prior art, *In re Oeticker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

The Applicant greatly appreciates the informal telephone conference with the Examiner on Monday, March 1, 2004, in which an amendment to the claims to change their recitation to water soluble cations not disclosed or taught by Atkinson was briefly discussed. The Examiner helpfully indicated that such amendments may permit the claims to be allowed over the Atkinson reference.

The Examiner's attention is respectfully directed to the amendments to independent claims 1 and 12 herein where the alkali metals lithium, potassium and cesium have been deleted from the Markush group of water soluble cations. Remaining in the water soluble cation Markush group are: sodium, calcium, zinc, ammonium, rare earths, and mixtures thereof. It is respectfully submitted that Atkinson does not teach or suggest brines where sodium, calcium, zinc, ammonium and/or rare earths are the water soluble cations to form a brine with the water.

The Applicant noted that the Examiner did not reject dependent claim 4 over Atkinson, which is appreciated. Claim 4 defines the water soluble cations to be zinc cations. Indeed, Atkinson does not teach, suggest or mention zinc cations. As noted, Atkinson also does not teach, suggest or mention sodium, calcium, ammonium or rare earth cations. It is therefore respectfully submitted that the amended claims reciting this list, and claims dependent thereon, are similarly patentable over Atkinson.

The Applicant would respectfully submit that the claims as amended are therefore allowable over Atkinson, and that the Examiner has not established a *prima facie* case of obviousness of the claims as amended over Atkinson. Reconsideration is respectfully requested.

It is respectfully submitted that the amendments and arguments presented above overcome all of the rejections. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,  
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